

REMARKS

Claims 1, 3-7, 9, 10 and 25 are now present in this application.

The title, abstract, specification, and claim 1 have been amended, claims 2, 8, and 11-24 have been cancelled without prejudice or disclaimer, and claim 25 has been added. Reconsideration of the application, as amended, is respectfully requested.

The Examiner has noted the Restriction Requirement which was given, as well as the election requirement. In response to these requirements, Applicant has elected Group I, Species A of Fig. 1, drawn to claims 1-7, 9 and 10. Without conceding the appropriateness of the Restriction Requirement, it is noted that the non-elected claims have now been cancelled without prejudice or disclaimer, simply in order to expedite prosecution of this application. Applicant reserves the right to file a Divisional application to these non-elected claims at a later time, if so desired.

The Abstract stands objected to and the title stands objected to for certain informalities. Because these informalities should now be addressed, it is respectfully requested that these objections now be reconsidered and withdrawn.

Claims 1-5 and 9 stand rejected under 35 USC 102(b) as being anticipated by ROTH, U.S. Patent 5,826,329. This rejection is respectfully traversed.

Claims 1, 6 and 7 stand rejected under 35 USC 102(b) as being anticipated by BRADY et al., U.S. Patent 5,826,328. This rejection is respectfully traversed.

Claim 10 stands rejected under 35 USC 103 as being unpatentable over ROTH. This rejection is respectfully traversed.

The patent to ROTH discloses a method of making printed circuit boards using thermal transfer techniques. In this method, the receiver board 14 is a fiberglass board or laminate, as set forth in column 2, lines 43-44. There is no suggestion in this arrangement that a method for forming radio frequency tags on paper or film is contemplated.

The present invention, on the other hand, is directed to a method of forming radio frequency tags. In independent claim 1, the receiver substrate is now recited as being paper or film. In particular, the step of "using" paper or film as a receiver substrate is expressly recited. This is a method step limitation. In addition, the last paragraph of claim 1 sets forth transferring a composition in order to enable a desired resonating pattern of the composition to be transferred to the paper or film receiver

substrate. This is unlike the rigid fiberglass flexible board disclosed in the ROTH patent.

It is respectfully submitted that the paper industry and semiconductor industries are not analogous art. One trying to make radio frequency tags on paper or film would not look to the teachings of ROTH. This is non-analogous art and in fact does not teach the method steps as recited in independent claim 1 of the present application.

In addition, both the ROTH and BRADY et al. patents do not disclose the arrangement of the thermal transfer ribbon of the present invention. The transfer ribbon in the present invention is an electrical conductor precursor or reactive material that becomes conductive upon application of heat. Independent claim 1 now recites that the composition transferred from the thermal transfer ribbon is an electrically conductive material. These limitations from claim 2 were not rejected by the BRADY et al. reference. It is additionally noted that dependent claim 3, which was also not rejected by the BRADY et al. reference, recites that the composition transferred from the thermal transfer ribbon is an electrical conductor precursor which becomes an electrically conductive material upon application of heat from the heat source. The ROTH reference also does not disclose such a feature.

Finally, regarding newly added dependent claim 25, it is noted that limitations from claim 6 are found in this claim. This claim now depends on claim 3, which was not rejected by the BRADY et al. reference. Original claim 6 was not rejected by the ROTH et al. reference. It is therefore logically submitted that this claim 25 would not be rejected by either reference. Nonetheless, as set forth above, independent claim 1 should set forth a method of forming electrically conductive pathways which is neither suggested nor rendered obvious by the prior art. This independent claim 1 as well as the dependent claim should all now be in condition for allowance. Accordingly, reconsideration and withdrawal of the 35 USC 102(b) and 103 rejections are therefore respectfully requested.

Favorable reconsideration and an early Notice of Allowance are earnestly solicited.

In the event that any outstanding matters remain in this application, the Examiner is invited to contact the undersigned at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Joe McKinney Murcy
Joe McKinney Murcy, #32, B34

KM/asc

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment: Abstract of the Disclosure